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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,481	03/14/2007	Thomas Wigger	125215	7244
25944	7590	08/21/2009	EXAMINER	
OLIFF & BERRIDGE, PLC			SELLERS, ROBERT E	
P.O. BOX 320850				
ALEXANDRIA, VA 22320-4850			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			08/21/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/552,481	WIGGER, THOMAS	
	Examiner	Art Unit	
	ROBERT SELLERS	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 October 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5 October 2005</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____. |

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1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-14 and 17, drawn to a two-component epoxy resin with a Mannich base in the hardener component.

Group II, claim 15, drawn to a fiber-reinforced composite.

Group III, claim 16, drawn to a method of adhesive bonding.

2. The inventions listed as Groups I, II and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature. The special technical feature is the Mannich base in the hardener component.

3. PCT Publication No. WO 00/016659 (page 12, Example 3) shows the mixing of a separate epoxy resin and Mannich base hardener derived from a mixture of cardanol monophenol and cardol diphenol with an aldehyde and a polyamine (page 3, second full paragraph). The special technical feature does not make a contribution over the prior art, thereby validating a holding of lack of unity.

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4. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

a) The epoxy resins such as the bisphenol A diglycidyl ether used in Table 2 on page 13 line 11 of the specification.

b) The reactants for the Mannich base such as the m-cresol, dimethylaminopropylamine tertiary amine (defined in claim 4) and diethylenetriamine (page 12 Table 1, DETA, defined in claim 8).

5. Applicant is required, in reply to this action, to elect a single species ***within each of items a) and b)*** to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Claims 1-17 are generic.

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6. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the reasons espoused with respect to the holding of lack of unity hereinabove.

A telephone call was made to Carrie Hank on July 6, 2009 to request an oral election to the above restriction and election of species requirements, but did not result in any elections being made.

7. The word ‘diglycidyl’ is misspelled on page 13, line 11.

8. There is no antecedent basis for the polyamine(s) of claims 7 and 8 in claim 1 wherfrom they depend.

9. Claims 12-14 provides for the use of the two-component epoxy resin composition, but since the claim does not set forth any steps involved in the process, it is unclear what process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 12-14 would be rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131,

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149 USPQ 475 (D.D.C. 1966).

10. The chemical names for the polyamines DAMP (1,3-diaminopentane according to page 4, lines 21-22), IPDA (isophoronediamine, page 5, line 7) and MPMD (1,5-diamino-2-methylpentane, page 4, lines 18-19) listed in claim 7 and 9 (IPDA, penultimate line) should be spelled out to clearly denote the compounds to one of ordinary skill in the art.

11. The phrase “selected from the group encompassing” utilized in claims 7 and 8, lines 2-3 is improper Markush language in the absence of the phrase “selected from the group consisting of.”

(571) 272-1093 (Fax No. (571)-273-8300)
Monday to Friday, 9:30 to 6:00

/Robert Sellers/
Primary Examiner
Division 1796

rs
8/19/2009